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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/024,806	12/19/2001	Peizhong Zheng	35718/241887 (5718-128)	6104

29122 7590 09/30/2003

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EXAMINER

BUI, PHUONG T

ART UNIT	PAPER NUMBER
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1638

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/024,806	ZHENG ET AL.	
	Examiner	Art Unit	
	Phuong T. Bui	1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3 and 5-11, drawn to a nucleic acid molecule and plant, classified in class 800, subclass 295.
 - II. Claims 1-11, drawn to an antisense nucleic acid molecule and plant, classified in class 536, subclass 24.5.
 - III. Claims 12-15, drawn to a plant containing two constructs, classified in class 800, subclass 278.
 - IV. Claims 16-20, drawn to a plant containing three constructs, classified in class 800, subclass 278.
 - V. Claim 21, drawn to a method of producing PHA, classified in class 435, subclass 69.1.
 - VI. Claim 22, drawn to a polypeptide, classified in class 530, subclass 372.

For each of inventions I-VI above, restriction to one of the following is also required under 35 USC 121. For inventions I, II and VI, election is required of one of inventions (A)-(L).

- (A). maize OAR
- (B). soybean OAR
- (C). SEQ ID No: 1 or a sequence encoding SEQ ID No: 2.
- (D). SEQ ID No: 3 or a sequence encoding SEQ ID No: 4.

(E). SEQ ID No: 5 or a sequence encoding SEQ ID No: 6.

(F). SEQ ID No: 7 or a sequence encoding SEQ ID No: 8.

(G) to (L). antisense of (A) to (F), respectively.

For invention III, election is required of one of inventions (A) to (L) and one of inventions i) to viii).

- i). Bacteria PHA synthase
- ii). SEQ ID No: 9
- iii). SEQ ID No: 10
- iv). GenBank Acc. No. M58445
- v). GenBank Acc. No. AF042276
- vi). EMBL Acc. No. A49465
- vii). EMBL Acc. No. X66592
- viii). DDBJ Acc. No. D8825

For inventions IV and V, election is required of one of inventions (A) to (L) and one of inventions i) to viii) and one of invention (1) to (8).

- (1). GenBank Acc. No. J05003
- (2). GenBank Acc. No. U04848
- (3). GenBank Acc. No. AF078795
- (4). EMBL Acc. No. AJ006237
- (5). DDBJ Acc. No. AB009237
- (6). GenBank Acc. No. L07893
- (7). DDBJ Acc. No. D43764

(8). GenBank Acc. No. U66242

2. The inventions are distinct, each from the other because of the following reasons:

Inventions (A)-(L), i)-viii), and (1)-(8) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects.

Inventions (I)-(VI) are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different effects. Invention I encodes polypeptides, Invention II regulates/inhibits expression, and inventions III-VI encode multiple polypeptides which are functionally and structurally distinct from each other.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, searches, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

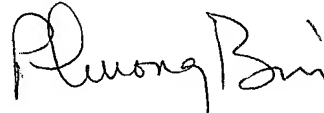
4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong T. Bui whose telephone number is 703-305-1996. The examiner can normally be reached on 6:30 AM - 4:00 PM; Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Phuong T. Bui
Primary Examiner
Art Unit 1638

ptb
September 23, 2003